

REMARKS

Applicant respectfully traverses the requirements for restriction. Applicant also elects the claims for group I.

I. RESTRICTION REQUIREMENT

To properly impose a restriction requirement, the Examiner must show: (1) that the claims are independent or distinct; and (2) there is a serious burden on the Examiner if restriction is not required. A serious burden on the Examiner may be *prima facie* shown if the Examiner shows separate classification of the inventions. *See* MPEP 803.

Applicant respectfully submits that Examiner has failed on both prongs of this test, namely that the inventions are not distinct, nor is there a serious burden on the Examiner if restriction is not required.

1. The claims of groups II and III:

With respect to the restriction of groups I and II, the Examiner states, "In this case the apparatus of invention II could be used for marketing activities, inventory purposes, or email communications, which consist of materially different processes."

The MPEP requires that, in order for process and apparatus claims for that process to be distinct, the apparatus as claimed must be capable of being used to practice another and materially different process. This means a process materially different than the process claimed in group I.

It appears that the Examiner has argued the apparatus of group II is capable of performing multiple processes (*i.e.*, "marketing activities, inventory purposes, or email communications") and averred that they are materially different from one another. However, this does not satisfy the test for restriction of the claims.

The processes of which the apparatus claims of group II are capable must be materially different than the process claimed in group I.

The Examiner has not shown that the apparatus as claimed in group II can be used to practice another and materially different process than that of group I's claims. Hence, it is respectfully submitted that Examiner has failed to make out a *prima facie* case for restriction of groups I and II.

Furthermore, even if the apparatus as claimed in group II could be used for marketing activities, inventory purposes, or email communications (and even if such terms are properly called "processes"), Examiner has not shown that the apparatus of group II would perform these activities by means of a process materially different than that of the process claimed in group I.

Finally, Examiner has not shown that the inventions for groups I and II cannot be classified in the same class. For example, the claims of group II are classed in class 709, subclass 217, while those of group I are placed by the Examiner in class 705, subclass 34. However, class 709 is defined thus:

"This class provides for an electrical computer or digital data processing system or corresponding data processing method including method or apparatus for transferring data or instruction information between a plurality of computers or processes wherein the computers or processes employ the data or instructions before or after transferring and the employing affects said transfer of data or instruction information."

It is respectfully submitted that the claims of group I can also reasonably be classified under such a definition, as Claim 1 of that group, for example, includes the concept of "accumulating, at a packet data serving node disposed between the mobile terminal and the packet data network...." Hence, it is respectfully submitted that the no undue burden has been shown on the Examiner if restriction is not required, because the claims of groups I and II could reasonably have been classified in the same class.

Hence, the restriction requirement is believed improper, and Applicant respectfully requests its withdrawal.

2. The claims of groups I and III:

In restricting groups I and III, the Examiner states, "In this case invention I could be carried out, at least in part, by hand. For example the step of detecting that communication has been established may be performed by an operator noticing that an email has been received and reading it then the accumulation of data could be additionally carried out by hand by an operator by entering the data from the email into a data packet serving node."

It is respectfully asserted that the claims of group I cannot be carried out by hand. For example, the Examiner mentions that the step of "detecting communication has been established" may be performed by an operator noticing that an email has been received. However, this is not performing the process step by hand, as a computer must be present, as well as a potential connection between the mobile terminal and the host.

Likewise, Examiner states that the step of accumulating of data at a packet data serving node can also be carried out by hand, e.g., by an operator who enters the data manually as it is received in email. However, this still requires necessary apparatus, and is not carried out "by hand" as that term is used in the MPEP.

It is respectfully submitted that the term, "by hand," in the context of restriction requirements, refers to the ability of someone to perform the process steps stated in the process claims without an apparatus for performing those process steps. For example, chemicals could be mixed "by hand," but they could also be mixed with a claimed mixing apparatus such as a blender. However, computer connections cannot be detected without the apparatus--the computer and the hardware for the connection itself.

Therefore, it is respectfully submitted that groups I and III are not properly restricted in this case.

3. The claims of groups II and III:

It is respectfully urged that the claims of groups II and III should not be subject to a restriction requirement. Examiner bases the restriction on the idea that groups II and III are "related as subcombinations disclosed as usable together in a single combination."

However, Applicant respectfully requests Examiner to clearly point out where the claims of groups II and III are disclosed as being usable together in a single combination. In the absence of such a showing, Applicant respectfully submits that restriction of these claims is improper.

II. Conclusion

It is respectfully urged that the claims of the present application should not be subject to a restriction requirement.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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